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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,076	02/20/2004	Frank Watts JR.	0122A	6275

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EXAMINER

SIMONE, CATHERINE A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,076	Applicant(s) WATTS ET AL.	
	Examiner Catherine Simone	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 34, 38, 39, 41-43, 47 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Bomboire (US 4,089,724).

Regarding claim 34, Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the second side of the film (see col. 5, lines 23-34). It is to be pointed out that the phrase “consisting essentially of” is being construed as equivalent to “comprising”.

Regarding claim 38, the print layer is at least partially viewable through the film (see col. 5, lines 1-5). Regarding claims 39 and 47, the discontinuous layer comprises first and second portions, the first portion having a gloss level different from the gloss level of the second portion (see col. 8, lines 66-68). Regarding claim 41, the film comprises a plurality of film layers (see col. 5, line 46). Regarding claim 42, the discontinuous layer has a portion in-register with a portion of the printed pattern or design (see col. 4, lines 21-27). Regarding claim 43, the film is a

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rigid or semi-rigid film (see col. 8, lines 8-9 and col. 9, lines 35-40). Regarding claim 48, the discontinuous layer comprises a flattening agent, a texturing agent and combinations thereof (see col. 8, lines 15-22).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the second side of the film (see col. 5, lines 23-34). Although Bomboire does teach a thickness of the discontinuous layer (see col. 9, lines 60-62), Bomboire fails to teach the discontinuous layer having a thickness between about 0.1 mils and less than about 0.5 mils, about 0.1 mils and about 0.45 mils and about 0.1 mils and about 0.4 mils. The optimum ranges for the thickness of the discontinuous layer would be readily determined through routine experimentation by one

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having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the thickness of the discontinuous layer in Bomboire to have a thickness between about 0.1 mils and less than about 0.5 mils, about 0.1 mils and about 0.45 mils and about 0.1 mils and about 0.4 mils, since since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

5. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724) in view of Schmidle et al. (US 4,273,819).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the first and second side of the film (see col. 5, lines 23-34). However, Bomboire fails to teach the print layer comprising a chemical embossing agent. Schmidle et al. teaches that it is old and well known in the art to have a print layer comprise a chemical embossing agent (see col. 13, lines 47-64) for the purpose of producing a chemical embossed pattern. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the print layer in Bomboire to comprise a chemical embossing agent as suggested by Schmidle et al. in order to provide a chemical embossed pattern.

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6. Claims 45, 46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724) in view of Schmidle et al. (US 4,273,819).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the first and second side of the film (see col. 5, lines 23-34). It is to be pointed out that the phrase “consisting essentially of” is being construed as equivalent to “comprising”.

However, Bomboire fails to disclose the film having a mechanically embossed surface texture and the mechanically embossed surface texture of the film being in-register with the pattern or design of the discontinuous layer.

Schmidle et al. teaches that it is old and well known in the art to mechanically emboss the surface of a wear layer of a differential gloss decorative sheet for the purpose of providing a flat, dead or dull mat finish or texture which is roughened, textured, corrugated, contoured, knurled, lined or the like.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the film in Bomboire with a mechanically embossed surface texture and have the mechanically embossed surface texture in-register with the pattern or design of the discontinuous layer as suggested by Schmidle et al. in order to provide a flat, dead or dull mat finish or texture which is roughened, textured, corrugated, contoured, knurled, lined or the like.

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7. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bomboire (US 4,089,724).

Bomboire discloses a coated freestanding film consisting essentially of a freestanding film having opposed first and second sides (Fig. 2, element 41); a print layer having a printed pattern or design, the print layer being disposed on the first side of the film (Fig. 2, element 31) and a discontinuous layer forming a pattern or design disposed on the second side of the film (Fig. 2, element 33; also see col. 5, lines 1-5) having a gloss level different from the gloss level of the first and second side of the film (see col. 5, lines 23-34). Although Bomboire teaches a vinyl film having plasticizer (see col. 9, lines 10-12), Bomboire fails to teach the vinyl film having less than 5 parts plasticizer per hundred parts by weight of the vinyl resin. The optimum range for the plasticizer would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the plasticizer in the vinyl resin of the film in Bomboire to be less than 5 parts per hundred parts by weight of the vinyl resin, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Response to Arguments

8. Applicant's arguments filed 6/12/06 have been fully considered but they are not persuasive. Applicant states "claim 34 has been amended to require the coated freestanding film to consist essentially of a freestanding film, a print layer and a discontinuous layer on the

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opposite side of the freestanding film from the print layer”. Applicant then argues “the freestanding film of Bomboire requires a support or base sheet 1, which is not interposed between the print layer and the discontinuous layer”.

However, it is to be pointed out that the transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). According to the MPEP, section 2111.03, for the purpose of applying prior art under 35 U.S.C. 102 and 103, “absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising”.” In the present application, there appears to be no clear indication in the specification and claims of what the basic and novel characteristics actually are. Furthermore, Applicant has not clearly stated that which would materially affect the basic and novel characteristics of the claimed invention. Therefore, the phrase “consisting essentially of” in claims 34 and 49 will be construed as equivalent to “comprising”. Thus, Bomboire clearly teaches the coated freestanding film as presently claimed.

Applicant further argues “the film Bomboire discusses at column 5, lines 44 to 46, is the support 1 and not the transparent sheet 41. Bomboire does not teach or suggest the transparent sheet 41, which is interposed between the printed decoration 31 and the discontinuously applied plastisol 33, comprise a plurality of layers”.

However, in column 4, lines 46-66, Bomboire teaches the film including a plurality of film layers. Therefore, Bomboire clearly teaches the film having a plurality of film layers as recited in claim 41.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CAS

Catherine A. Simone
Examiner
Art Unit 1772
August 11, 2006


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SUPERVISORY PATENT EXAMINER

8/11/06

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